

### **REMARKS**

In a telephone message received on October 4, 2007, Examiner Graham indicated that the Applicant's previous amendment filed on March 2, 2007 was not entered. Applicant is therefore re-entering those amendments herein.

#### **Request for Correction/Amendment of Inventorship**

Applicant filed a Request for Correction/Amendment of Inventorship under 37 C.F.R. § 1.48(a), with associated documents on March 2, 2007, to add Stephen Titus as an inventor in this application. The error in omitting Mr. Titus as an inventor occurred without deceptive intention on the part of the Applicant. Entry of the amended inventorship is respectfully requested.

#### **Amendment to Specification**

The Specification has been amended to add a new paragraph at page 9, following line 24. This amendment specifies that, by way of example only, an optional outer coating of a wood, such as 0.005 inch maple veneer 46, can be adhesively joined to the outer surface of the shaft 12.

Support for this amendment can be found in U.S. Patent 6,110,051 (the '051 patent), issued to the present inventors, at col. 5, lines 30-32. The present application claims priority to the '051 patent, and the subject matter of the '051 patent was incorporated by reference into the parent application of the present application, U.S. 09/649,473, which was itself incorporated by reference into the present application. Thus, the subject matter of this paragraph was present in the present application as filed, and no new matter has been added.

#### **Amendment to the Claims**

In an Office Communication mailed on June 5, 2007, the United States Patent and Trademark Office (hereinafter "USPTO") objected to an Amendment filed on March 2, 2007<sup>1</sup> as being non-responsive to the Office Action dated October 10, 2006. With the entry of the present

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<sup>1</sup> The Office Communication erroneously indicates that the Amendment was filed on March 6, 2006. The Amendment was mailed by the Applicants on March 2, 2007 and received by the USPTO on March 6, 2007.

amendment, it is believed that the objection for non-responsiveness is overcome, and that all rejections in the October 10, 2006 Office Action are also overcome.

In the March 2, 2007 amendment, Claims 1, 7, and 9 were cancelled, and Claims 10 through 13 were added, with Claim 10 as the only independent claim. The Office Communication states that the March 2, 2007 Amendment was “non-responsive” according to section 821.03 of The Manual of Patent Examining Procedure (hereinafter “MPEP”). The Office Communication further states that:

the remaining claims are not readable on the elected invention because newly submitted claim 10 and all of the claims dependent thereon are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 10 is directed to a separate wood and composite embodiment cue stick whereas the originally presented claims were directed solely to a composite embodiment stick. Since Applicant has received an action on the merits for the originally presented invention, the composite embodiment has been constructively elected by original presentation for prosecution on the merits.

Applicant respectfully disagrees with the Examiner that the Applicant has “constructively elected” embodiments that are “directed solely to a composite embodiment stick.” It is submitted that the Examiner has misinterpreted the scope of the originally presented claims. None of the claims presented prior to the March 2, 2007 amendment were limited “*solely* to a composite embodiment stick.” Independent Claim 1, for example, as presented on July 30, 2004, recited “a shaft formed of a material including fibers disposed in a binder...” The word “including” means that other materials, in addition to “fibers disposed in a binder,” may form the shaft. Those other materials can include wood, as would be understood by one skilled in the art from the reading disclosure of the present application.

Nevertheless, in order to expedite prosecution of this application, new independent Claim 14 is being filed with this Amendment. New Claim 14 is similar in scope to prior Claim 1, which was cancelled in the March 2, 2007 Amendment, but further clarifies the scope of the Applicant’s invention.

Claim 14 is now the sole independent claim. Claims 3 and 8 are being amended to depend on Claim 14. New Claims 15-17 have been added to alternatively characterize the present invention. Claims 7 and 9 have been cancelled. The amendments and additions to the

Claims are fully supported by the specification of the present invention and do not add new matter.

Rejection of the Claims from the Office Action mailed on October 10, 2006

In the Office Action mailed on October 10, 2006, all pending claims were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over McCarty *et al.* (U.S. Patent No. 5,725,437) (hereinafter “the McCarty ’437 patent”).

As previously discussed, Claims 1, 7, and 9 have been cancelled, Claims 3 and 8 have been amended, and Claims 14 through 17 have been added. For the following reasons, it is respectfully submitted that the Claim rejections are all overcome, and that the present application is allowable.

The present claim rejections are inapplicable to the pending claims, because the cited McCarty ’437 patent is not prior art with respect to these claims. The present application is a continuation of U.S. Application Serial No. 09/649,473 (hereinafter “the ’473 application”), filed on August 28, 2000, which is expressly incorporated by reference into the present application. The ’473 application is a continuation-in-part of U.S. Application Serial Nos. 08/825,249 (issued as U.S. Pat. No. 6,162,128), and of 09/200,244 (issued as U.S. Pat. No. 6,110,051), filed on March 27, 1997 and November 25, 1998 respectively, both of which were expressly incorporated by reference into the ’473 application. U.S. Application Serial No. 08/825,249 is a continuation of U.S. Application Serial No. 08/314,864, which issued as the McCarty ’437 patent. U.S. Patent No. 6,110,051 (hereinafter “the McCarty ’051 patent”) was filed on November 25, 1998 as U.S. Application No. 09/200,244. The McCarty ’051 patent fully supports the subject matter being claimed in the present application. The inventors of the ’051 patent are Allan McCarty and Steve Titus. Thus, the effective filing date of the present claims is at the very latest November 25, 1998. The cited McCarty ’437 patent was issued on March 10, 1998, which is less than one year prior to the November 25, 1998 effective filing date of the present claims. Therefore, the McCarty ’437 patent is not a valid reference under § 102(b), and the § 102(b) anticipation rejections are not applicable to the pending claims.

Furthermore, the inventors of the present application, Allan McCarty and Stephen Titus, filed U.S. Provisional Application 60/066,589 on November 25, 1997, a copy of which is

attached hereto as Exhibit A.<sup>2</sup> This provisional application also fully supports the presently-pending claims, and demonstrates that the inventors had conceived and constructively reduced to practice the subject matter of the present claims by at least November 25, 1997, which is prior to the issue date of the cited McCarty '437 patent. Thus, it is submitted that the McCarty '437 patent is not valid prior art against the pending claims under any subsection of 35 U.S.C. § 102, and therefore could not be applied in an obviousness rejection under 35 U.S.C. § 103. Support for the claims of the present application can be found within the specification of the McCarty '051 patent and U.S. Provisional Application Serial No. 60/066,589 (hereinafter, "the '589 provisional"). Therefore, the McCarty '437 patent is not prior art with respect to these claims.

Support for newly-added independent Claim 14 can be found in the McCarty '051 patent at, for example, col. 3, lines 4-10 and at col. 4, lines 50-67. Support in the '589 provisional can be found at pages 4 and 7.

Support for amended dependent Claim 3 can be found in the McCarty '051 patent at, for example, col. 4, lines 34-36. Support in the '589 provisional can be found at pages 6-7.

The McCarty '437 patent supports Claim 8 at, for example, col. 5, lines 6-9. Claim 8 is supported by the McCarty '051 patent, which incorporates the McCarty '437 patent by reference. Claim 8 is also supported by the '589 provisional, which incorporates the McCarty '437 patent by reference.

The McCarty '437 patent supports newly-added Claim 15 at, for example, col. 5, lines 6-9. Claim 15 is supported by the McCarty '051 patent, which incorporates the McCarty '437 patent by reference. Claim 15 is also supported by the '589 provisional, which incorporates the McCarty '437 patent by reference.

Support for newly-added dependent Claim 16 can be found in the McCarty '051 patent at, for example, col. 5, lines 30-32. Claim 16 is also supported by the '589 provisional at page 8.

Support for newly-added dependent Claim 17 can be found in the McCarty '051 patent at, for example, col. 5, lines 30-32. Claim 17 is also supported by the '589 provisional at page 8.

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<sup>2</sup> The first paragraph of the specification of the McCarty '051 patent references and claims the benefit of this provisional application, properly identifying the provisional application by its filing date, inventors and title, but erroneously transposing the final three digits of the Serial Number (60/066,895 instead of 60/066,589). Applicants believe this is an obvious typographical error that does not affect the validity of the priority claim, and is correcting this error in each application in the chain of priority.

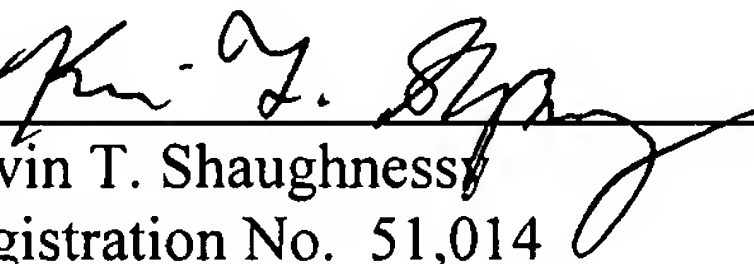
In view of the above, it is respectfully submitted that the claim rejections are traversed, and it is requested that the application be allowed.

**CONCLUSION**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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